

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 14822US02)**

In the Application of:

Jeyhan Karaoguz, et al.

Serial No. 10/675,491

Filed: September 30, 2003

For: Method and System for Secure
Linking with Authentication and
Authorization in a Media
Exchange Network

Examiner: Ryan, Patrick A.

Group Art Unit: 2427

Confirmation No. 6014

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
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Sir:

This Reply Brief responds to the Examiner's Answer mailed on August 26, 2009. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-26 of the present application for at least the reasons set forth in the Appeal Brief and this Reply Brief.

REMARKS

The Examiner's Answer sets forth essentially the same arguments as the Final Office Action. *Compare* Examiner's Answer at pages 3-19 *with* March 9, 2009 Office Action at pages 7-22. Indeed, the Examiner's Answer indicates that the "ground(s) of rejection are applicable to the appealed claims as presented in Final Office Action mailed March 9, 2009." See Examiner's Answer at page 3. Accordingly, the Appeal Brief addresses these arguments at pages 6-15.

Nevertheless, the Examiner's Answer raises new issues in its "Response to Argument" section at pages 19-30. To the extent that these issues are not merely the same reasoning in the Final Office Action, the Applicants will address them below.

I. The Proposed Combination Of Ellis And Takanashi Does Not Render Claims 1-12 And 14-15 Unpatentable

A. The Proposed Combination Of References Does Not Describe, Teach Or Suggest "Requesting Affirmative Confirmation Using Said Received Address Correlation Information Associated With One Or Both Of The Television Display And/Or The Storage"

In response to the Applicants' explanation that the cited references do not describe, teach or suggest "requesting affirmative confirmation using said received address correlation information associated with one or both of the television display and/or the storage," the Office Action resorts to reading various limitations from the Applicants' specification into the claim language. See Examiner's Answer at pages 20-21.

As an initial matter, the Applicants are perplexed that the Examiner imports language from the specification into the claims, because such a practice clearly runs afoul of patent examining procedure. See, e.g., Manual of Patent Examining Procedure at § 2111.01(II) ("IT IS IMPROPER TO IMPORT CLAIM LIMITATIONS FROM THE SPECIFICATION").

"Though understanding the claim language may be aided by explanations contained in the written description, **it is important not to import into a claim**

limitations that are not part of the claim.” See *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)

Nevertheless, in order to overcome the deficiencies of the cited reference as explained in detail by the Applicants (see Appeal Brief at pages 7-11), the Examiner uses statements **from the Applicants’ specification** to support the rejections. The Applicants respectfully submit, however, that attempting to import language from the specification into the claims is an improper examination procedure, and is at odds with Federal Circuit precedent, as well as the MPEP, as noted above.

Additionally, even after using the Applicants’ specification in an attempt to bolster the cited references, the Examiner’s Answer still does not explain where any of the cited references describe, teach or suggest a **request for affirmative confirmation**, in general, or a request for affirmative confirmation using received address correlation information associated with one or both of a television display and/or a storage, in particular. **The claim terms are clear and understandable**. However, the Examiner’s Answer employs a long, convoluted and confusing argument (see Examiner’s Answer “Response to Argument” at pages 19-25, for example,) that imports limitations from the specification, among other tactics, in a strained attempt to maintain the claim rejections. Yet, “[o]rdinary, simple English words whose meaning is clear and unquestionable, absent any indication that their use in a particular context changes their meaning, are construed to mean exactly what they say.” See MPEP 2111.01(I), *citing Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004). “[W]ords of the claim must be given their plain meaning” See MPEP at 2111.01 (citations omitted).

Moreover, as noted in the Appeal Brief at page 9, for example, the Examiner’s Answer still does not clearly indicate what it considers the “request,” or “affirmative confirmation” with respect to the cited references (as opposed to the Applicants’ specification). See Examiner’s Answer at pages 20-25. Again, the Examiner does not point to anything specific in Ellis or Takanashi as a “request,” or “affirmative

confirmation” of such a request. See *id.* Indeed, a review of the Examiner’s Answer leaves one hard-pressed to determine just what **from the cited references** (as opposed to the Applicants’ specification or possibly extrinsic evidence) it considers a request for confirmation. See Examiner’s Answer at, for example, page 24 (“The Examiner submits that the ‘request’ at Step 610 of Takanashi has not been associated with Appellant’s claimed ‘requesting’”).

The Examiner’s Answer simply does not point to anything specific in the **cited references** that it considers a “request for affirmative confirmation.” The closest the Examiner’s Answer does so appears at page 25 of the Examiner’s Answer:

The Examiner has addressed the act of ‘requesting affirmative confirmation using said received address correlation information’ with Takanashi’s teaching of a client device logging into a Network 110, which requires a valid IP address, and a User ID and password

See Examiner’s Answer at page 25. The Examiner’s Answer also states that “transmission of a **DHCPACK message** represents an ‘affirmative confirmation’....” See *id.* (emphasis added). Again, however, the Examiner’s Answer simply does not point to “affirmative confirmation” or a “request” for as much in **the cited references**. “DHCPACK” is nowhere to be found in Takanashi (see Takanashi), so the Applicants are unsure as to what exactly the Examiner’s Answer is referring to with respect to that term.

Further, the Applicants demonstrate that the portions of Takanashi that the Office Action relies on do not describe, teach or suggest the relevant limitations. See Appeal Brief at pages 7-10. Whether or not this process requires a “valid IP address” (see Examiner’s Answer at page 25) or that a term, such as DHCPACK, which is nowhere to be found in the cited references, represents something (see *id.*), does not remedy the fact that the Examiner’s Answer is unable to point to where “requesting affirmative confirmation” is found in **any of the cited references**.

Notably, however, the Examiner’s Answer seems to resort to relying on the

Applicants' **own specification** to reject the pending claims. See *id.*, e.g., at page 22 ("In view of the above cited passages of the [Applicants'] specification ..."), page 23 ("As presented above, the Examiner has construed, in view of the [Applicants' specification..."), and page 24 ("It is the Examiner's position that Appellant's Specification..."). Such a practice, as indicated above, runs afoul of patent examining procedure.

Also, the Examiner's Answer notes that "Takanashi discussed in Paragraph [0034], 'IP assignment system 125 **receives (610) a request for an IP address in the form of a DHCP broadcast from a client.**'" See Examiner's Answer at page 24 (emphasis added). However, as the Applicants explain, a request for an IP address is by no means a **request for affirmative confirmation**, as recited in the claims. See Appeal Brief at pages 7-10. Further, the Applicants do not contest that an IP address, DHCP broadcast, etc. may be **used** in various systems and methods. However, none of the cited references describes, teaches or suggests using an IP address, DHCP broadcast, etc. for example, to **request affirmative confirmation**, as recited in the claims, or that an IP address or DHCP broadcast *is* a request for affirmative confirmation.

The Examiner's Answer is simply unable to directly point to anything in the cited references that describes, teaches or suggests the relevant limitations noted above. Instead, in an attempt to maintain the rejections, the Examiner's Answer employs logic that is convoluted and very confusing. See Examiner's Answer 19-25. The Applicants respectfully submit that this logic in the Examiner's Answer, which is unquestionably difficult to follow, clearly demonstrates that the claim rejections are misplaced. In other words, if the cited references did clearly disclose the relevant limitations, the Examiner's Answer would have quickly pointed to where, and succinctly explain how, as opposed to a logical process that takes up numerous pages, imports language from the specification into the claims, and relies on terms that are not even found (e.g., "DHCPACK") in the cited references. The Applicants note that it is up to the Examiner

to establish a *prima facie* case of unpatentability in order for the rejections to be sustained. See, e.g., 35 U.S.C. § 102 (“A person shall be entitled to a patent unless...”). However, the Applicants respectfully submit that the Examiner’s Answer does not establish such a *prima facie* case, as explained in the Appeal Brief and this Reply Brief. Accordingly, the Applicants are under no obligation to submit evidence of nonobviousness:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

Additionally, the Examiner’s Answer seems to be relying on extrinsic evidence (“RFC 2131”) that has not been provided to the Applicants or submitted into evidence in the present Appeal.

As explained in the Appeal Brief and above, the Examiner’s Answer has not shown that any of the cited references describe, teach or suggest “**requesting affirmative confirmation**” using said received address correlation information associated with one or both of the television display and/or the storage,” as recited in claim 1, for example. Claims 6 and 12 recite similar limitations. Thus, for at least these reasons, the Applicants respectfully request reconsideration of the rejection of claims 1-12 and 14-15.

B. The Proposed Combination Of References Does Not Describe, Teach Or Suggest Storing A Request For Confirmation, As Recited In Claims 1 And 7

The Applicants also demonstrate that the proposed combination of references does not describes, teach or suggest “storing said affirmative confirmation,” as recited in claims 1 and 7. See Appeal Brief at pages 10-11.

The Examiner’s Answer states the following:

The Examiner has presented that Takanashi demonstrates the storage of affirmative confirmation by way of DHCP reply

packet by way of a DHCP reply packet containing the IP address, leasing time, and renewal window data (Final Office Action Page 8 and Takanashi **Paragraph [0022]-0023]**.

See Examiner's Answer at page 26 (emphasis added). However, as explained above, the Examiner's Answer does not even show that any of the cited references describes, teaches or suggests "affirmative action," let alone storing as much.

Moreover, the portions of Takanashi relied upon, namely Paragraphs [0022]-[0023] disclose receiving a "DHCP broadcast from a client" and "requesting an IP address" (see Takanashi at [0022]) and forwarding a DHCP reply packet to a client (see *id.*), but the cited portions that the Office Action relies on do not necessarily describe, teach or suggest "storing" the DHCP broadcast or a reply packet, and clearly do not describe, teach or suggest "storing" **an affirmative confirmation**. Additionally, the Examiner's Answer seems to be relying on extrinsic evidence ("RFC 2131") that has not been provided to the Applicants or submitted into evidence in the present Appeal.

As explained in the Appeal Brief and above, the proposed combination of Ellis and Takanashi does not describe, teach or suggest storing affirmative confirmation, as recited in claims 1-7. For at least this additional reason, the proposed combination of references does not render claims 1 and 7 unpatentable.

II. The Proposed Combination Of Ellis And Takanashi Does Not Render Claims 2 And 8 Unpatentable For An Additional Reason

The Applicants demonstrate that the combination of Ellis and Takanashi does not render claims 2 and 8 unpatentable for an additional reason. See Appeal Brief at page 12.

The Applicants note that there is nothing in the portions of Takanashi that the Office Action relies upon (namely, Takanashi at [0022], [0023] and [0034]-[0037]) that describes, teaches or suggests "**verifying that said affirmative confirmation has been stored**." See Appeal Brief at page 12. The Office Action has not cited anything

from the cited references that describes, teaches or suggest these limitations of claims 2 and 8.

III. The Proposed Combination Of Ellis, Takanashi And Humpleman Does Not Render Claim 13 Unpatentable

The Applicants also respectfully request reconsideration of the rejection of claim 13 as being unpatentable over the proposed combination of Ellis in view of Takanashi and Humpleman for at least the reasons discussed above with respect to claims 1 and 12.

IV. The Proposed Combination Of Ellis And Yoon Does Not Render Claims 16-18 And 20-26 Unpatentable

The Applicants demonstrate that the proposed combination of Ellis and Yoon does not render claims 16-18 and 20-26 unpatentable. See Appeal Brief at pages 13-15. In particular, the Applicants expose the flawed logic employed in the Final Office Action and the Examiner's Answer. See *id.*

The reasoning in the Examiner's Answer assumes the Connection Authentication Server is **both** the processor and the first device as recited in the claim. Accordingly, the Authentication Server 50 would seemingly have to issue and authenticate access information from itself to itself. However, such a reading is nonsensical, particularly in view of the fact that **the claim is written to explicitly indicate that the at least one processor is different than the first device**. That is, the Applicants did not draft the claim so that two different terms represented the same device, as such a reading would be confusing. If these components were to be mean the same thing, they would not be phrased differently. Thus, for at least these reasons, the Applicants respectfully submit that the reasoning in the Office Action with respect to claim 16 is flawed and should therefore be reconsidered.

The Applicants also explain that the Final Office Action (and therefore the Examiner's Answer) also fails to show that any of the cited references describes, teaches or suggests "authenticat[ing] said access information by said first device **when**

said third device attempts to transfer at least one of media data and service to said at least said second device.” See *id.* at pages 14-15. Notably, the portion of Yoon relied on by the Examiner’s Answer discloses that the local computer 30 requests a connection authentication to the connection authentication server 50 **before** **requesting services to the target internet server 60.”** See *id.* The cited portions most certainly do not describe, teach or suggest **when** the local computer 30 attempts to transfer at least one of media data and service to the Internet Server 60.

However, the Examiner strains to maintain the rejection by asserting the following:

The Examiner submits that no particular time frame is established in Claim 16 to provide any particular meaning to the word “when” and that the claim merely requires that the even [sic] occurs.

See Examiner’s Answer at page 30.

However, the Applicants are confused by this statement as the claim clearly and unequivocally recites “when,” but not “before” or “after.” See, e.g., Webster’s Collegiate Dictionary, 10th Ed., at page 1341 (“when: ... at or during the time that... just at the moment that ... the time or occasion at or in which ...”). Again, “[o]rdinary, simple English words **whose meaning is clear and unquestionable**, absent any indication that their use in a particular context changes their meaning, **are construed to mean exactly what they say.**” See MPEP 2111.01(I), citing *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004) (emphasis added).

Thus, for at least the reasons set forth in the Appeal Brief and above, the Applicants respectfully request reconsideration of the rejection of claims 16-18 and 20-26. Indeed, for at least these reasons, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to these claims.

V. The Proposed Combination Of Ellis, Yoon And Woodhill Does Not Render Claim 19 Unpatentable

The Applicants respectfully request reconsideration of the rejection of claim 19 as being unpatentable over the proposed combination of Ellis in view of Yoon and Woodhill for at least the reasons discussed above with respect to claim 16.

VI. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-26.

No fee is believed due with respect to this Reply Brief. However, the Commissioner is authorized to charge any necessary fees, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: October 2, 2009

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